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09/318,353	05/25/1999	CHARLES L. CASAGRANDE	38916/14140	1317

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/318,353

Applicant(s)

CASAGRANDE, CHARLES L.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Continued Prosecution Application

1. The request filed on November 13, 2002 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/318,353 is acceptable and a CPA has been established. An action on the RCE follows.

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2. Claims 1, 12, 13, 19 and 23 have been amended for further examination.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the distance between an edge of the patch layer and a corresponding edge of the form layer is less than distances between other patch and corresponding form layer edges, as is stated in Claim 7, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-10, 12-23 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1, line 11 recites the limitation "the patch layer, adhesive layer and form layer portion comprising an integral label". The scope of the claim is unclear as written because it appears as though the patch layer, the adhesive layer, and form layer in combination make up an integral label. Does the integral label comprise an additional limitation? Should this state that "the patch layer....comprises an integral label"?

5. Claim 12, line 11; Claim 15, line 15; Claim 19, line 13; Claim 25, line 13, each recite the limitation "the patch layer, adhesive layer and form layer portion comprising the fold-over card intermediate". There is insufficient antecedent basis for this limitation in the claim. Should this state that "the patch layer....comprises the fold-over card intermediate"?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1, 3, 12, 14, 16, 25 and 28, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Popat et al.

Popat et al discloses in Fig. 4 and 7, a form with integrated label comprising: a form layer (60) having a top surface (A), a bottom surface (62) a peripheral edge; at least one die cut (68 and 70) through the top and bottom surfaces within the periphery of the form layer defining at least one portion (60 which is between 68 and 70) or card intermediate; a patch layer (80) divided by a perforation line (82) and having a peripheral edge (72 and 76), composed of translucent material, having top surfaces (80a) and bottom surface (80b); a layer of repositionable, peelable adhesive (58), wherein the bottom surface of the patch layer is adhesively but removably secured (due to release coating 64) to the top surface of the form layer over the entire die cut and form layer portion in which the patch layer, adhesive layer and form layer comprises an integrated label (as seen in Fig. 7); and wherein the adhesive layer has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer such that when the label (as seen in Fig. 7) is removed from the form, the portion of the adhesive layer (portion on left side of die cut 72 and left side of 68 as seen in Fig. 4) that is not between the patch layer and the form layer portion (portion of 60 between 68 and 70) is exposed and stays adhered to the bottom surface of the patch layer (this can also be seen in Fig. 3, top portion wherein when the label is lifted, the exposed adhesive can be seen around the die-cut perimeter).

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7. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoyagi (4,032,679).

Aoyagi discloses in Fig. 2 and 3, a form with integrated label comprising: a form layer (23) having a top surface (A), a bottom surface (B) a peripheral edge (C); at least one die cut (25) through the top and bottom surfaces and within the periphery of the form layer defining at least one portion (23a and 23b); a patch layer (21) having a peripheral edge (D and E), having top surfaces (F) and bottom surface (G); a layer of repositionable, peelable adhesive (22), wherein the bottom surface of the patch layer is adhesively but removably secured to the top surface of the form layer over the entire die cut and form layer portion in which, the patch layer, adhesive layer and form layer comprises an integrated label (as seen in Fig. 3); and wherein the adhesive layer (22) has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer such that when the label (as seen in Fig. 3) is removed from the form, the portion of the adhesive layer (22 as seen in Fig. 3) that is not between the patch layer and the form layer portion (23a and 23b) is exposed and stays adhered to the bottom surface of the patch layer (this can also be seen in Fig. 3; a top portion wherein when the label is lifted, the exposed adhesive can be seen around the die-cut perimeter); wherein the form layer further contains multiple die-cuts (S) within the die-cuts (25); and wherein the integrated label comprises a second label (seen in Fig. 3).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi

Aoyagi discloses in Fig. 2 and 3, a form comprising all the elements as claimed in Claim 1, and as set forth above.

However, Aoyagi does not disclose: wherein the patch layer is composed of translucent material consisting of paper glassine or polyester film; wherein the patch layer is opaque and is sized and offset in relation to the die cut in the form layer such that the distance between an edge of the patch layer and a corresponding edge of the form layer portion is less than that between other corresponding edges, and is greater than that between other corresponding edges.

In regards to **Claims 4 and 5**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design

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choice. *In re Leshin*, 125 USPQ 416. Furthermore, applicant has not indicated that the material of the patch layer is critical to the workability of the invention.

In regards to **Claims 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the patch layer in any desirable offset location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, it would have been an obvious matter of design choice to construct the patch layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Applicant has not indicated that the claimed location and size of the patch layer was critical to the workability of the invention.

9. Claims 4-7, 17 and 18, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al.

Popat et al discloses in Fig. 4 and 7, a form comprising all the elements as claimed in Claims 1 and 12, and as set forth above.

However, Popat et al does not disclose: wherein the patch layer is composed of translucent paper glassine or polyester film; wherein the patch layer is opaque and is sized and offset in relation to the die cut in the form layer such that the distance between an edge of the

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patch layer and a corresponding edge of the from layer portion is less than that between other corresponding edges, and is greater than that between other corresponding edges.

In regards to **Claims 4, 5, 17 and 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Furthermore, applicant has not indicated that the material of the patch layer is critical to the workability of the invention.

In regards to **Claims 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the patch layer in any desirable offset location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, it would have been an obvious matter of design choice to construct the patch layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Applicant has not indicated that the claimed location and size of the patch layer was critical to the workability of the invention.

10. Claims 2, 10, 15, 21, 22, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Blum et al (4,204,706).

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Popat et al discloses a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat et al further discloses the bottom surface (62) of the form layer being able to accept indicia.

However, Popat et al do not disclose the top surface of the patch layer and the top surface of the form layer being able to accept indicia.

Blum et al discloses in Fig. 2 and Col. 3, lines 50-56, a form with integrated label having a patch layer (19) and a form layer (17) in which indicia can be accepted on the top surfaces thereof through the use of "spot carbonized" method, so that when marking pressure is applied to the outer top surface of the patch layer, a corresponding ink mark is produced on the top surface of the form layer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's form to include indicia on the top surface of the form layer and patch layer as taught by Blum et al for the purpose of eliminating the requirement that the patch be folded back to permit marking of indicia on the form surface.

Allowable Subject Matter

11. Claims 13, 19 and 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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12. Claims 14-18 of Claim 13, 26, and 28 of Claim 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments filed on November 11, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the Popat et al reference does not disclose a patch layer having a peripheral edge between the peripheral edge of the form layer but outside the die cuts of the form layer portion, the examiner submits that the Popat et al reference does indeed disclose this claim limitation as shown in Fig. 4 and as set forth in the rejections above. The peripheral edge does not have to be the outer edge of the entire layer, but only the outer edge of the element set forth as the patch layer. In this case the patch layer is deemed as segments (66, in Fig. 3) having a peripheral edge (72, 74, 76 and 78). The examiner has also rejected the claims as being unpatentable over the Aoyagi reference.

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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Smith, Bernstein, and Rawlings also disclose forms having integrated labels.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

January 27, 2003

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